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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,516	12/30/1998	DENNIS M. O'CONNOR	INTL-0134-US	1486

7590 12/30/2003

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EXAMINER
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NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 12/30/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/223,516

Applicant(s)

O'CONNOR ET AL.

Examiner

HUY T NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-15 and 28-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-15 and 28-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 12-15 and 28-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woo (5,485,219) in view of Vogel (4,097,893).

Regarding claims 12, 14-15 and 28-39, Woo discloses a transmitter (Fig. 1) and a receiver, the transmitter comprising: a monitor that monitors an ongoing video transmission and provides an indication (code command) separately received when a characteristic is detected; and a transmission device that transmits said video

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transmission together with said indication, wherein said transmission device is an over the air broadcast television transmitter (Fig. 1, Abstract) or cable television transmitter transmission (column 3, lines 30-35, line 41 to column 4, line 15) and the receiver comprises a medium for storing instructions that cause a computer to monitor an ongoing video transmission for a predetermined characteristic; and upon detecting said characteristic, automatically record said video transmission by a recorder ( column 5, line 27 to column 8, line 17, columns 10 and 11).

Woo fails to specifically teach that the recording command is transmitted together with video transmission. However, it is noted that transmitting a start command signal together with a video transmission is well known in the art as taught by Vogel . Vogel at figure 3, teaches means for inserting command code (indicating signal), which separately received from a monitor , in a vertical interval of a video transmission to control a recorder to record a selected portion of a video transmission indicating by a start command (Fig. 3, column 5, lines 30-50). It would have been obvious to one of ordinary skill in the art to modify Woo with Vogel by using a inserting means as taught by Vogel for transmission the recording command along with the video transmission by inserting the recording command in a vertical blanking intervals that use for carrying closed captioned of the video transmission , as an alternative method for transmitting the recording command signal of Woo, for transmitting the recording command along with the video transmission.

Further Woo and Vogel teaches monitoring the command by generating command into a command code and insert the command code into the video

transmission

Further for claim 32 and 36, Woo as modified Vogel fails to specifically teach monitoring a replay that is a video segment retransmitted. However, it is noted that transmitting a replay of a video transmission is well known in the art. Therefore official notice is taken and it would have been obvious to one of ordinary skill in the art to modify Woo as modified with Vogel with by using the transmitter of Woo for receiving , monitoring a replay of the video transmission and generating the coded command as characteristic indicative a replay to enable the receiver to record a replay when a user of the receiver request .

Regarding claim 13, Woo fails to specifically teach that the video transmission is from a satellite transmitter. However, it is noted that using a satellite transmitter for transmitting video signal is well known in the art . Therefore, official notice is taken and it would have been obvious to one of ordinary skill in the art to modify Woo by using a satellite transmitter for transmitting video transmission.

3. Claims 32 , 33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akira (JP61-017241A) in view of official notice .

Regarding claims 32,33 and 36 , Akira discloses a method comprising: transmitting a video transmission together with a coded command to begin recording of the video transmission (Abstract, Figs. 1-2) and a recorder for automatically recording a desired segment of the video transmission .

Akira fails to specifically teach that the segment is a replay that is immediate retransmitted. However, it is noted that video transmission having a replay is well known

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in the art . Therefore official notice is taken and would have been obvious to one of ordinary skill in the art to modify Akira by transmitting the coded command together with a replay of the video transmission thereby enabling the recorder to record a replay as desired segment .

Applicant argues that Akira does not teach that the command coded is transmitted together with the video transmission . In response, the examiner disagrees. It is noted that at figure 2, Akira teaches a start record command and end recording command are transmitted at the beginning of the selected segment and at the end of the selected segment of the video transmission.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to 2600 TECH CENTER customer service whose telephone number is (703) 306-0377.

  
HUY NGUYEN  
PRIMARY EXAMINER

H.N

December 29, 2003